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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/591,406

Applicant(s)

KAMADA, TOMIHIISA

Examiner

Amar Daglawi

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-16,18-27 and 29-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9-16,18-27 and 29-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Claims 2, 8, 17, and 28 have been cancelled. Claims 1, 3-7, 9-16, 18-27, 29-32 are pending in the application. The amendment has been entered.

Response to Arguments

1. Applicant's arguments with respect to claims 1, 3-7, 9-16, 18-27, 29-32 have been considered but are moot in view of the new ground(s) of rejection in view of the amendment filed 04/07/2008.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 3, 7, 9-13, 15, 16, 18-26, 27, 29-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed limitation **"while leaving the uploaded data in the memory"** raises the issue of new matter. The claimed limitation is not supported by applicant's disclosure in such a way to reasonably convey to one skilled in the relevant art at the time the application was filed had possession of the claimed invention.

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 recites the limitation **"said uploading being performed with only data updated"** on page 2 or line 27 of the claims pending. There is insufficient antecedent basis for this limitation in the claim.
6. All dependent claims from claim 1 are rejected for the same reason.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-7, 9-13, 15-16, 18-27, 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Takayama (EP 0950 968 A1).

With respect to claim 1, Takayama discloses a wireless communication terminal synchronization method in which data stored in a memory in each of plural wireless communication terminals is synchronized with each other, when a user selectively utilizes the plural wireless communication terminals by using a single subscriber information card, at least communicating operation in each of the wireless communication terminals being enabled by mounting thereon the subscriber information card that records subscriber information, the method comprising the steps of:

uploading from a first wireless communication terminal with the subscriber information card being mounted, to a server via a communication network, updated part of data which is stored in a memory in the first wireless communication terminal, in accordance with a user's request or automatically said uploading being performed with only data updated after the subscriber information card was mounted on the first wireless communication terminal while leaving the uploaded data in the memory in the first wireless communication terminal wherein said uploading is allowed to be executed at least under conditions that the user is confirmed to be an authenticated user of said subscriber information card and an authenticated user of the first wireless communication terminal (Fig.1, #100, #110, abstract, par [2106-2111]) [The data updated and uploaded to the server is kept in the memory of the terminal 139 and the same data is downloaded to a terminal that differs when attaching the SIM card. Also, uploading occurs when authenticating the user after entering a code number that matches a code number stored in the nonvolatile memory] (See par [2111-2112])

updating contents in a user's data storage area with the data being uploaded, in the server (par [2111]);

downloading the data to a second wireless communication terminal via the communication network from the server, the data being confirmed in accordance with a user's request or automatically, as data to be downloaded to the second wireless communication terminal from the server, after the subscriber

information card having been demounted is mounted on the second wireless communication terminal said downloading being performed with only data which is present in the storage area of the server and which is not present in the memory of the memory of the second wireless communication terminal wherein said downloading is allowed to be executed at least under conditions that the user is confirmed to be an authenticated user of said subscriber information card and an authenticated user of the second wireless communication terminal (Fig.1, par [2111-2115]; and [The data updated and uploaded to the server is kept in the memory of the terminal 139 and the same data is downloaded to a terminal that differs when attaching the SIM card. Also, uploading occurs when authenticating the user after entering a code number that matches a code number stored in the nonvolatile memory] (See par [2111-2112])

updating the contents of the memory in the second wireless communication terminal, said uploading being performed with only data updated after the subscriber information card was mounted on the second wireless communication terminal, while leaving the uploaded data in the memory in the second wireless communication terminal, wherein said uploading is allowed to be executed at least under conditions that the user is confirmed to be an authenticated user of said subscriber information card and an authenticated user of the second wireless communication terminal.(par [2111-2115])

With respect to claim 3, Takayama further teaches uploading is allowed to be executed at least under conditions that the wireless communication terminal that requested the uploading is confirmed to be a terminal being associated with said

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subscriber with said subscriber information card in advance (par [2109;2112, par [2115])).

With respect to claim 4, Takayama further teaches the conditions are confirmed on the terminal side (par [2111-2115]).

With respect to claim 5, Takayama further teaches the conditions are confirmed on the server side (par [2111-2115]).

With respect to claim 6, Takayama further teaches data attribute as a target of said uploading and said downloading is registered in advance and in each of the terminals only the data having the data attribute registered in each own terminal becomes the target of the uploading and the downloading (par [2106-2115])

With respect to claim 7, Takayama discloses A wireless communication system comprising plural wireless communication terminals at least communication operation of which is enabled by mounting a subscriber information card recording subscriber information, and a server that is connected with the wireless communication terminals via a communication network, said server comprising:

a communication interface which performs data communication with said wireless communication terminals via the communication network (Fig.1, #110, par [2106; 2109]).

a storage unit which includes a storage area to store a copy of the data stored in said plural wireless communication terminals (Fig.140, #14000, par [2106; 2109]); and a

server side synchronization engine which synchronizes the data of a user stored in the wireless communication terminals and the data stored in the storage unit according to a request from any one of said wireless communication terminals (Fig.1, #110; par [2106;2109], par [2111-2115]) [When attaching SIM card to a different terminal data is downloaded and synchronization (data consistency between the plural mobiles) of the data is achieved];

each of the wireless communication terminals comprising:

a card reader which detachably mounts a subscriber information card (Fig.140, #14001);

a wireless communication interface which is operable when said subscriber information card is mounted (Fig.140; #14001; par [2111; 2112]);

a memory (Fig.140, #1501) which stores user data; and a terminal side synchronization engine (Fig.140, #14000) which requests execution of synchronization to said server after said subscriber information card is mounted, uploading or downloading of data being executed with said server as required said uploading being performed with only data updated after the subscriber information card was mounted on the wireless communication terminal leaving the uploaded data in the memory and said downloading being performed with only data which is present in the storage unit of the server and which is not present in the memory of the wireless communication terminal(par [2106-2115]); and at least either one of said server and each of said wireless communication terminals further comprising:

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an authentication engine (SIM card, Fig.140, #14000) which allows only plural wireless communication terminals possessed by an identical user, to perform synchronization as to the user data of the user in the storage unit of said server (par [2106;2109], par [2111;2115]).

said authentication engine being adapted to allow synchronization to be executed at least under conditions that the user who requested the synchronization is confirmed to be an authenticated user of said subscriber information card and an authenticated user of the terminal (par [2111-2115]).

With respect to claim 9, Takayama further discloses said authentication engine confirms that the user of the terminal that requested the synchronization is an authenticated user of said subscriber information card on the basis of personal identification information being associated with said subscriber information card (par [2109; 2112], par [2115]).

With respect to claim 10, Takayama further teaches authentication engine (SIM card) confirms that the user is an authenticated user of the terminal on the basis of personal identification information being associated with the wireless communication terminal (par [2109; 2112], par [2115]).

With respect to claim 11, Takayama further teaches authentication engine allows executing the synchronization under conditions that the terminal that requested the synchronization is confirmed to be the terminal that is associated with the subscriber

information card in advance (par [2109; 2112], par [2115]) [The confirmation occurs when attaching the SIM card to the terminal].

With respect to claim 12, Takayama further teaches authentication engine is provided in the terminal so as to store in a memory of the terminal the subscriber information card, and in performing authentication, it is checked whether the subscriber identification information of the subscriber information card mounted on the wireless communication terminal and the subscriber identification information stored in the memory of the terminal as a target for authentication match with each other, thereby confirming that the terminal requested the synchronization is a terminal being associated with said subscriber information card in advance (par [2109; 2115]).

With respect to claim 13, Takayama further teaches said authentication engine is provided in the terminal so as to store in the memory of the subscriber information card mounted on the terminal, the terminal identification information recorded in the terminal, and in performing authentication, it is checked whether any of the plural terminal identification information stored in the memory of the subscriber information card and the terminal identification information recorded in the terminal as a target of the authentication match with each other, thereby confirming that the terminal requested the synchronization is a terminal being associated with the subscriber information card in advance (par [2109;2115]) [The confirmation occurs when attaching the SIM card to the terminal].

With respect to claim 15, Takayama discloses A wireless communication terminal at least communication operation of which is enabled by mounting a subscriber information card that records subscriber information, said terminal comprising:

a card reader which detachably mounts a subscriber information card (Fig.140, #14002);

a wireless communication interface which is operable when the subscriber information card is mounted (Fig.1, #140; #1517)

a memory means which stores user data (Fig.1, #1501); and a terminal side synchronization engine (Fig.140, #14000) which requests execution of synchronization to the server on the communication network after the subscriber information card is mounted, and executes uploading or downloading of data with the server as required said uploading being performed with only data updated after the subscriber information card was mounted on the terminal leaving the uploaded data in the memory and said downloading being performed with only data which is present in a storage unit of a server and which is not present in the memory of the terminal and wherein said synchronization engine allows the synchronization to be executed at least under conditions that the user of the terminal who requested the synchronization is confirmed to be an authenticated user of said subscriber information card and an authenticated user of the terminal(Fig.140, par [2106-2115]).

With respect to claim 16, Takayama further teaches authentication engine (SIM card) which allows only plural wireless communication terminals possessed by an

identical user to perform synchronization for the user data of the user in a storage unit in said server (Fig.140, #14000, par [2111-2115]).

With respect to claim 18, Takayama further teaches said authentication engine confirms that the user of the terminal that requested the synchronization is an authenticated user of said subscriber information card on the basis of personal Identification information being associated with said subscriber information card (par [2109; 2112], par [2115]).

With respect to claim 19, Takayama further teaches authentication engine (SIM card) confirms that the user is an authenticated user of the terminal on the basis of personal identification information being associated with the wireless communication terminal (par [2109; 2112], par [2115]).

With respect to claim 20, Takayama further teaches authentication engine allows executing the synchronization under conditions that the terminal that requested the synchronization is confirmed to be the terminal that is associated with the subscriber information card in advance (par [2109; 2112], par [2115]) [The confirmation occurs when attaching the SIM card to the terminal].

With respect to claim 21, Takayama further teaches authentication stores in the subscriber identification information recorded in said subscriber information card and performing authentication, it is checked whether the subscriber identification information of the subscriber information card mounted on the terminal and the subscriber identification information stored in the memory of the terminal as a target for

authentication match with each other, thereby confirming that the terminal requested the synchronization is a terminal being associated with said subscriber information card in advance (par [2109-2115]).

With respect to claim 22, Takayama further teaches said authentication engine stores the terminal identification information recorded in the terminal in the memory in the subscriber information card mounted on the terminal, and in performing authentication, it is checked whether any of the plural terminal identification information stored in the memory in the subscriber information card and the terminal identification information recorded in the terminal as a target of the authentication match with each other, thereby confirming that the terminal requested the synchronization is a terminal being associated with the subscriber information card in advance (par [2109-2115]) [The confirmation occurs when attaching the SIM card to the terminal].

With respect to claim 23, Takayama further teaches a card detector (Fig.140, #14002) which detects mounting and/or demounting of said subscriber information card, wherein, said terminal side synchronization engine (SIM card, Fig.140, 14000) accesses said server triggered by detecting the mounting and/or demounting of said subscriber information card, and requests execution of the synchronization (par [2111;2115]).

With respect to claim 24, Takayama further teaches a battery remaining amount detecting section said terminal side synchronization engine accesses said server triggered when the battery remaining amount becomes a predetermined level or less

and requests execution of synchronization including at least data uploading (par [2113-2117]).

With respect to claim 25, Takayama further teaches said terminal side synchronization engine is provided with a judging engine which judges whether or not the terminal or not the terminal is in idle state and executes the synchronization process when said judging engine determines that the terminal is in idle state (par [2106-2108]).

With respect to claim 26, Takayama further teaches said terminal synchronization engine accesses said server in response to a directive from a user and uploads data as a target for uploading and then erases a predetermined data in the terminal all at once (par [2106-2108]).

With respect to claim 27, Takayama discloses A server being connected via a communication network with plural wireless communication terminals at least communication operation of which is enabled by mounting thereon a subscriber information card that records subscriber information, said server comprising:

a communication interface which performs data communication with said wireless communication terminals via the communication network (Fig.140, #110);

a storage unit which has a storage area to store a copy of the data that is stored in said plural wireless communication terminals (Fig.140, #14000, par [2106; 2109]); a server side synchronization engine which performs synchronization with said wireless

communication terminals for user data stored in said storage unit, in accordance with a request from said wireless communication terminals said synchronization being performed with only data updated after the subscriber information card was mounted on one of the wireless communication terminals while leaving uploaded data stored in the wireless communication terminal (Fig.1, #110, par [2106; 2109], par [2110-2115] [when attaching SIM card to a different terminal data is downloaded and synchronization is achieved]; and

an authentication engine (Fig.140, #14000) which allows only plural wireless communication terminals possessed by an identical user to perform synchronization for the user data of the user in the storage unit wherein said authentication engine allow synchronization to be executed at least under conditions that the user is confirmed to be an authenticated user of said subscriber information card and an authenticated user of the wireless communication terminal on which said subscriber information card is mounted (par [2111-2115], par [2106-2109]).

With respect to claim 29, Takayama further discloses said authentication engine confirms that the user of the terminal that requested the synchronization is an authenticated user of said subscriber information card on the basis of personal identification information being associated with said subscriber information card (par [2109; 2112], par [2115]).

With respect to claim 30, Takayama further teaches authentication engine (SIM card) confirms that the user is an authenticated user of the terminal on the basis of

personal identification information being associated with the wireless communication terminal (par [2109; 2112], par [2115]).

With respect to claim 31, Takayama further teaches authentication engine allows executing the synchronization under conditions that the terminal that requested the synchronization is confirmed to be the terminal that is associated with the subscriber information card in advance (par [2109; 2112], par [2115]) [The confirmation occurs when attaching the SIM card to the terminal].

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 14 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takayama (EP 0950 968 A1) in view of Utsumi (US 2005/0125344 A1).

With respect to claims 14 and 32, Takayama teaches all the limitations of claims 7 and 31 except for a server comprises subscriber managing database to register the subscriber identification information of the subscriber information card and terminal identification information of plural wireless communication terminals of the user in such a manner as being associated with each other; said authentication engine receiving from the wireless communication terminal, subscriber identification information recorded in said subscriber information card and terminal identification information of the wireless communication terminal on which the subscriber information card is mounted, and confirming that the terminal identification information thus received is registered in the subscriber managing database, in such a manner as being associated with the subscriber identification information thus received, thereby confirming that the terminal that requested the synchronization is a terminal that is associated with said subscriber information card in advance which is taught in related art by Utsumi (See par [0011]).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Takayama to incorporate a server and a plurality of member-users and a database as taught by Utsumi so as to provide personal information verification method in an electronic commerce system.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amar Daglawi whose telephone number is 571-270-1221. The examiner can normally be reached on Monday- Friday (7:30 AM- 5:00 AM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yuwen Pan can be reached on 571-272-7855. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Amar Daglawi/
Examiner, Art Unit 2618

/Yuwen Pan/
Primary Examiner, Art Unit 2618